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CLARK HILL, P.C.
500 WOODWARD AVENUE, SUITE 3500
DETROIT, MI 48226

In re Application of LIN et al :
U.S. Application No.: 10/585,628 :
PCT Application No.: PCT/CA2005/000152 :
Int. Filing Date: 07 February 2005 : DECISION
Priority Date Claimed: 06 February 2004 :
Attorney Docket No.: 19339-106126 :
For: TRIM DOOR HARDWARE CARRIER AND :
METHODS OF ASSEMBLING VEHICLE DOOR :

This is in response to applicant's petition under 37 CFR 1.47(a) filed 15 June 2009.

BACKGROUND

On 07 February 2005, applicant filed international application PCT/CA2005/000152, which claimed priority of an earlier United States application filed 06 February 2004. A copy of the international application was communicated to the USPTO from the International Bureau on 18 August 2005. The thirty-month period for paying the basic national fee in the United States expired on 06 August 2006.

On 11 July 2006, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 16 April 2009, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 15 June 2009, applicant filed the present petition under 37 CFR 1.47(a).

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2)

factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

With regard to item (1) above, the declarations filed with the petition are improper. In particular, it is not sufficient to submit a fragment (i.e. a signature page) of a declaration. Furthermore, it is not acceptable to combine fragments (i.e. signature pages) of different copies of a declaration into a single document for submission. Applicant must submit either: (1) a single complete declaration which is presented to and executed by all of the available inventors or (2) multiple complete declarations, wherein each available inventor executes at least one of the multiple complete declarations.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made. . . . The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions.

* * *

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. . . . It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. In re Gray, 115 USPQ 80 (Comm'r Pat. 1956).

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The

document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

The petition states that joint inventor Manfred Fritsch cannot be reached. However, it appears that the letter dated 30 January 2007 was successfully delivered to inventor Fritsch's forwarding address. Thus, it would not be reasonable to conclude that inventor Fritsch cannot be located. It is noted that petitioner has not alleged that inventor Fritsch refuses to sign.

With regard to item (3) above, applicant has provided the requisite petition fee.

With regard to item (4) above, although the petition states the last known address of the nonsigning inventor is "144 Country Lane, Ringgold, GA 30736", correspondence sent to that address could not be delivered. Furthermore, correspondence sent to "P.O. Box 37, St. John, VI 00831-0037" was delivered successfully. Therefore, petitioner should explain why "144 Country Lane, Ringgold, GA 30736" is still believed to be inventor Fritsch's last known address.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Extensions of time are available under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Bryan Lin

Bryan Lin
PCT Legal Examiner
PCT Legal Office

Telephone: 571-272-3303
Facsimile: 571-273-0459